

### **REMARKS**

In response to the Office Action mailed June 16, 2009, the assignee of this application respectfully requests reconsideration. To further the prosecution of this application, each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 1-2, 4-6 and 20-24 were previously pending in this application. No claims are amended, added or canceled. As a result, claims 1-2, 4-6 and 20-24 remain pending for examination, with claims 1 and 20 being independent. No new matter has been added.

#### **Claim Rejections Under 35 U.S.C. §102**

Each of independent claims 1 and 20 is rejected under 35 U.S.C. §102(e) as purportedly being anticipated by U.S. Patent Publication No. 2004/0003041 to Moore, et al. ("Moore"). The rejections of claims 1 and 20 are respectfully traversed.

#### **A. Claim 1**

1. The Rejection Of Claim 1 Reflects A Misapprehension Of The Office's Burden In Making An Anticipation Rejection

Claim 1 recites a method comprising steps of, *inter alia*, transmitting a first text message, transcribed from a speech input by a teleconferencing system, to a plurality of instant messaging devices participating in an instant messaging based conference; and transmitting a speech output, converted from a second text message received from any one among the plurality of instant messaging devices, to a plurality of telephones participating in a teleconference.

The Office Action's statements regarding how these limitations are believed to be met by Moore reflect a misapprehension of the Office's burden in making an anticipation rejection. The Office Action does not cite passages of Moore which explicitly disclose transmitting a first text message, transcribed from a speech input by a teleconferencing system, to a plurality of instant messaging devices participating in an instant messaging based conference, or transmitting a speech

output, converted from a second text message received from any one among the plurality of instant messaging devices, to a plurality of telephones participating in a teleconference. Rather, the Office Action cites passages of Moore which disclose disparate and unrelated system capabilities which the Office Action theorizes could potentially be used together, in ways that Moore does not even remotely suggest. As such, the Office Action appears to adopt the position that the method of claim 1 can be rejected as anticipated if the system of Moore is believed to be capable of performing the recited steps, even if Moore does not explicitly disclose the system performing the recited steps, and indeed even if Moore does not disclose that the system is capable of doing so. This is clearly improper.

MPEP §2131 explicitly provides that to make a properly supported anticipation rejection of claim 1 over Moore, the Office Action must point to passages of Moore in which the steps of the method of claim 1 are either explicitly or inherently disclosed as being performed. MPEP §2131. As discussed in the sections that follow, Moore does not disclose or suggest either (1) transmitting a first text message, transcribed from speech input, to a plurality of instant messaging devices, or (2) transmitting a speech output, converted from a second text message, to a plurality of telephones participating in a teleconference.

2. Moore Does Not Disclose Or Suggest Transmitting A Speech Output, Converted From A Text Message, To A Plurality Of Telephones Participating In A Teleconference

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In support of its contention that Moore discloses transmitting a speech output, converted from a text message, to a plurality of telephones participating in a teleconference, the Office Action cites two passages of Moore. In the first passage (i.e., ¶[0087]), Moore discloses that a service provider system 30 (shown in FIG. 1) may provide services which include conference call establishment (¶[0087]). This passage is part of a section in which Moore discloses that the services which service provider system 30 may make available to a user of a chat client 14 via instant messaging include directory assistance, customer support, concierge services, conference call establishment, etc. (¶[0087]). By making these services available via instant messaging, the system

provides information to the user in text form rather than speech form, allowing the user to copy and paste the information into another application (§§[0074]–[0091]).

In the second cited passage (i.e., §§[0103]–[0104]), Moore discloses a capability to translate text input received at chat client 14 to speech output for delivery to, for example, telephone 62 (§§[0103]–[0104]). This passage is part of a description of intelligent media translator 70 (FIG. 1), which Moore discloses is capable of converting text input received at chat client 14 to speech for output via telephone 62, and speech input received via telephone 62 to text for output via chat client 14 (§§[0103]–[0104]).

The Office Action concludes, based on Moore's disclosure of conference call establishment and text-to-speech conversion capabilities (provided by separate, disparate components), that Moore discloses transmitting a speech output, converted from a text message, to a plurality of telephones participating in a teleconference. This contention is entirely unsupported by the reference. Nowhere does Moore say anything about transmitting any speech output, converted from a text message by intelligent media translator 70, to a plurality of telephones participating in a teleconference established by service provider system 30. Indeed, Moore says nothing at all about these two unrelated capabilities of the system being used together. Rather, the only disclosure by Moore of any transmission of text converted to speech to a telephone is to a single telephone 62 (see, e.g., §§[0103]–[0104] and [0116]).

Because Moore does not explicitly disclose transmitting a speech output, converted from a text message, to a plurality of telephones participating in a teleconference, a rejection of claim 1 over Moore would only be proper if Moore inherently disclosed performing such a transmission. The standard for making an inherency rejection is an exceedingly difficult one to meet. In this respect, MPEP §2112(IV) provides (emphasis added):

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances *is not sufficient*.

Thus, even if it were possible that the system of Moore might provide a capability to transmit a speech output converted from a text message to a plurality of telephones (which the assignee does not concede), that possibility does not come close to satisfying the inherency standard. Rather, to satisfy this standard, Moore must make clear that the system *necessarily* transmits a speech output converted from a text message to a plurality of telephones participating in a teleconference.

Moore does not describe a system that necessarily transmits a speech output converted from a text message to a plurality of telephones participating in a teleconference. For example, the disclosure by Moore in ¶[0087] of conference call establishment services provided by service provider system 30 is entirely consistent with conference calls in which multiple users each provide speech input to corresponding telephones, and the text-to-speech conversion capabilities disclosed in ¶[0103]-[0104] may produce output that is delivered to a single telephone. As a system with these capabilities would be consistent with Moore's disclosure and not meet the claim limitations requiring that a speech output converted from a text message be transmitted to a plurality of telephones participating in a teleconference, Moore clearly does not disclose a system that necessarily satisfies these limitations.

In view of the foregoing, Moore neither explicitly nor inherently satisfies the limitations of claim 1 directed to transmitting a speech output converted from a text message to a plurality of telephones participating in a teleconference.

2. Moore Also Does Not Disclose Or Suggest Transmitting A Text Message, Transcribed From A Speech Output Received At A Speech Processing Device, To A Plurality Of Instant Messaging Devices

Moore also fails to satisfy the claim 1 limitation directed to transmitting a text message, transcribed from speech input received at a teleconferencing system from a telephone, to a plurality of instant messaging devices participating in an instant message based conference. In Applicant's last response, it was pointed out that in Moore's system, any text message transcribed from speech input is sent to only a single instant messaging device (i.e., chat client 14 (FIG. 1)). In this respect,

Moore discloses that the system allows chat client 14 and an operator/station 142 to interact within a communication session (see, e.g., ¶[0082]). While Moore discloses that a chat request from chat client 14 may be distributed to multiple operators/ stations 142 (¶[0132]), and that chat client 14 may communicate with multiple operators/stations 142 in a chat room (¶¶[0082]-[0083]), Moore says nothing about a communication that originates from an operator/station 142 being transmitted to a plurality of instant messaging devices, let alone a text message transcribed from speech input, as recited by claim 1.

In the “Response To Argument” section, the Office Action alleges that Moore “repeatedly” discloses that more than one chat client 14 is provided, even though only one chat client is depicted in FIG. 1. The assignee respectfully points out that even if this contention were supported by the reference, a disclosure by Moore that the system depicted in FIG. 1 can include multiple chat clients does not satisfy the claim limitation. Rather, to satisfy the limitation, Moore must explicitly or inherently disclose transmitting a text message transcribed from a speech input to a plurality of instant messaging devices participating in an instant message based conference.

Moore clearly does not explicitly disclose transmitting a text message transcribed from a speech input to a plurality of instant messaging devices participating in an instant message based conference. In the passages cited by the Office Action (i.e., ¶¶[0030], [0075] and [0083]), Moore merely discloses that the system supports communication among multiple parties. In ¶[0030], Moore discloses that the system manages communications among a plurality of sending parties and recipient messaging stations (¶[0030]). In ¶[0075], Moore discloses that a “principal” employing chat client 14 may communicate with one or more other principals via the network (¶[0075]). In ¶[0083], Moore discloses that a chat client may join a chat room in which other system users participate (¶[0083]). Nowhere, in the cited passages or elsewhere, does Moore say anything about transmitting a text message, transcribed from a speech input, to a plurality of instant messaging devices.

Moore also does not inherently disclose transmitting a text message, transcribed from a speech input, to a plurality of instant messaging devices. As discussed above, to satisfy the inherency standard, Moore must make clear that the system *necessarily* performs such a

transmission. Moore does not do so. For example, the disclosure by Moore in ¶[0030] of managing communications among multiple parties, in ¶[0075] of a user of chat client 14 being able to communicate with one or more other principals, and in ¶[0083] of chat client 14 participating in a chat room is entirely consistent with interactions in which only text is transmitted from a sender to one or more recipients. As a system that operates in this manner would be consistent with Moore's disclosure and yet not meet the claim limitations directed to transmitting a text message, transcribed from a speech input, to a plurality of instant messaging devices, Moore does not disclose a system that necessarily meets these limitations. Thus, Moore also does not inherently satisfy this limitation of claim 1.

In view of the foregoing, Moore neither explicitly nor inherently satisfies the limitations of claim 1 directed to transmitting a text message, transcribed from a speech input, to a plurality of instant messaging devices.

3. Claim 1 Patentably Distinguishes Over Moore

Because Moore does not explicitly or inherently disclose transmitting a first text message, transcribed from speech input, to a plurality of instant messaging devices, or transmitting a speech output, converted from a second text message, to a plurality of telephones participating in a teleconference, Moore fails to satisfy all of the limitations of claim 1. As such, the rejection of claim 1 under 35 U.S.C. §102(e) as purportedly being anticipated by Moore should be withdrawn.

A. Claim 20

Claim 20 recites a speech processing device comprising at least one processor programmed to, *inter alia*, transmit a first text message, transcribed from a speech input by a teleconferencing system, to a plurality of instant messaging devices participating in an instant messaging based conference; and transmit a speech output, converted from a second text message received from any one among the plurality of instant messaging devices, to a plurality of telephones participating in a teleconference.

It should be appreciated from the discussion above relating to claim 1 that Moore fails to explicitly or inherently disclose a speech processing device comprising at least one processor programmed to transmit a first text message, transcribed from a speech input by a teleconferencing system, to a plurality of instant messaging devices participating in an instant messaging based conference; and transmit a speech output, converted from a second text message received from any one among the plurality of instant messaging devices, to a plurality of telephones participating in a teleconference, as recited by claim 20. As such, the rejection of claim 20 under 35 U.S.C. §102(e) as purportedly being anticipated by Moore should be withdrawn.

Claim Rejections Under 35 U.S.C. §103(a)

Each of claims 1 and 20 is also rejected as purportedly being obvious over Moore.

The Office Action contends that Moore satisfies all of the limitations of each of claims 1 and 20 except for those directed to a speech processing device being adapted to provide a bridge between a teleconferencing system and a messaging system, and being coupled between the teleconferencing system and the instant messaging system directly and/or via a data network. As should be appreciated from the discussion above relating to the rejection of claims 1 and 20 under §102, Moore also fails to satisfy the claim limitations directed to transmitting a first text message, transcribed from a speech input by a teleconferencing system, to a plurality of instant messaging devices participating in an instant messaging based conference; and transmitting a speech output, converted from a second text message received from any one among the plurality of instant messaging devices, to a plurality of telephones participating in a teleconference. As Moore fails to satisfy all of the limitations recited by either of claims 1 or 20, even if Moore were modified in the manner alleged in the Office Action, neither of these claims is obvious over such a modified system of Moore for at least this reason.

The Office Action also contends that the limitations directed to the speech processing device being adapted to provide a bridge between a teleconferencing system and a messaging system, and being coupled between the teleconferencing system and the instant messaging system directly

and/or via a data network, reflect a mere design choice which, absent unexpected advantages, does not lend patentability. This contention is respectfully traversed.

In support of this contention, the Office Action cites MPEP §2144.04.VI.C, which states that an example rationale supporting a conclusion of obviousness is that a claim recites a mere rearrangement of parts found in the prior art. The cited section is part of MPEP §2144.04, which describes limited circumstances under which legal precedent may be cited as a source of supporting rationale. MPEP §2144.04 explicitly states that legal precedent may only be used as supporting rationale “if the facts in [the] prior legal decision are sufficiently similar to those in an application under examination.”

MPEP §2144.04.VI.C states that the decision discussed therein (i.e., *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)) involved claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch. The court held the claims unpatentable because shifting the position of the starting switch would not have modified the operation of the device. The facts in *In re Japikse* are not only not similar to those present here, they are entirely unrelated. How the placement of a starting switch on a hydraulic power press could be thought to be similar to the adaptation of a speech processing device to provide a bridge between a teleconferencing system and a messaging system is entirely unclear.

Moreover, even if the facts of *In re Japikse* were similar to those present here, MPEP §2144.04.VI.C explicitly states that the mere fact that parts could be rearranged to meet the claim limitations is not by itself sufficient to support a conclusion of obviousness. Rather, “[t]he prior art must provide a motivation or reason for [one skilled in] the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” Here, the prior art provides no such reason. Moore discloses no deficiency in the disclosed system which would provide a reason to rearrange parts so that a speech processing device is adapted to provide a bridge between a teleconferencing system and a messaging system.

In view of the foregoing, the rejection of claims 1 and 20, and of the claims that depend respectively therefrom, under 35 U.S.C. §103(a) as purportedly being obvious over Moore should be withdrawn.



Dependent Claims

Because each independent claim is believed to distinguish over the prior art of record, the patentability of any dependent claim has not been separately argued, solely to expedite prosecution and focus on issues central to the allowability of all claims. The assignee does not, however, concede agreement with the manner in which the Office Action interprets any dependent claim, or that the additional limitations recited by any dependent claim are satisfied by the prior art of record. The assignee reserves the right to separately argue the patentability of any dependent claim in the future, despite seeing no reason to do so at this time.

**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. N0484.70559US00.

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Respectfully submitted,  
Nuance Communications, Inc.

By  

Richard F. Giunta  
Registration No.: 36,149  
WOLF, GREENFIELD & SACKS, P.C.  
Federal Reserve Plaza  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2206  
617.646.8000